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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,443	07/18/2003	Karen Luke	2000-IP-002115U1P1	4704
28857	7590	08/21/2008		
CRAIG W. RODDY HALLIBURTON ENERGY SERVICES P.O. BOX 1431 DUNCAN, OK 73536-0440			EXAMINER FIGUEROA, JOHN J	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 08/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/623,443	Applicant(s) LUKE ET AL.	
	Examiner JOHN J. FIGUEROA	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 138 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,40,43-47,49,53-55,58,61,62,65,106,110,113-121,125,128-132 and 134-137 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/2008 & 7/15/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 33,40,43-47,49,53-55,58,61,62,65,106,110,113-121,125,128-132 and 134-138.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission (amendment), filed on July 10, 2008. The request has been deemed proper and this application has been hereby examined in view of said amendment.

Response to Amendment

2. The 35 U.S.C. 103(a) rejection of claims 33, 40, 43-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 as unpatentable over USPN 4,548,734 to Chaux et al. (hereinafter 'Chaux') has been maintained for reasons previously made of record of record in items 2 and 6 on pages 2 and 3, respectively, of the Final Office Action date April 10, 2008 (hereinafter 'FOA') has been withdrawn.

Election/Restrictions

3. The outstanding election/restriction had been previously made final in item 4 of FOA.

Response to Arguments

The 35 U.S.C. 103(a) Rejection over Chaux (item 6 of FOA)

4. Applicant's arguments with respect to the captioned 35 U.S.C. 103(a) rejection of claims 33, 40, 43-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 as unpatentable over Chaux have been fully considered but deemed unpersuasive.

Applicant's arguments that the current amendment, deleting "about" from the range for the weight percent of zeolite in the composition is not persuasive.

As stated previously, Chaux discloses in, col. 11, lines 37-42, a formulation wherein the zeolite component of the composition can be present in a range of 7 to 40% of the composition; surfactant in a range 0 to 10% (optional); and water in a range of 15 to 37%. The zeolite in this formulation can thereby be present in, e.g., 40%, the surfactant 1% and water 37%. If so, it is present in an amount $40/(100-38)$ of the *dry materials*, which is about 65%. Even including the water-soluble gum component (30-70%) as part of the dry mix (i.e., it is not dissolved in water first before adding it to the solution), this embodiment of Chaux's formulation would provide a composition having 40% zeolite present, 30% water-soluble gum 30% and the balance water/surfactant. The zeolite would thus be present in amount of 57.2%, which is close to 60%, the lower limit for the range recited in the claim.

Although the ranges in the claims, as currently amended, do not contain the term “about”, because the weight percentage for zeolite disclosed in the prior art is close enough to touch the ranges recited in the claims, a *prima facie* case of obviousness still exists. See MPEP 2144.05.

“[A] *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). “[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness.” *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). See also *In re Harris*, 409 F.3d 1339, 74 USPQ2d 1951 (Fed. Cir. 2005)(claimed alloy held obvious over prior art alloy that taught ranges of weight percentages overlapping, and in most instances completely encompassing, claimed ranges; furthermore, narrower ranges taught by reference overlapped all but one range in claimed invention).”

Further, as stated in FOA, it is uncertain from the specification as to what the definition of “dry mix” actually encompasses to be able to ascertain this weight percentage for the range. In paragraph [0042] on page 8 of the present specification, Applicant discloses that “in one embodiment, the zeolite-containing well bore treating fluid may be prepared as a *dry mix including some or all of the above-identified components*, except for the carrier fluid.” Consequently, because the term “dry mix” is not defined in the claims and the present specification teaches that “dry mix” can be interpreted as including the zeolite component and one or more of the disclosed

additives, it is uncertain why Chaux's formulation would not encompassed by the range limitation for the weight percentage of zeolite in the instant independent claims.

Thus, the instant claims, as amended, remain unpatentable over Chaux.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN J. FIGUEROA whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JJF/RAG

/John J. Figueroa/

Examiner, Art Unit 1796